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Processing of, and Requirements for, the Filing of Duplicate Applications and Papers in Patent Applications in view of USPS Mail Delays

Office of Patent Legal Administration << Pre-OG Notices << Processing of, and Requirements for, the Filing of Duplicate Applications and Papers in Patent Applications in view of USPS Mail Delays

Although mailed correspondence is being received by the United States Patent and Trademark Office (USPTO or Office), many papers that were mailed by first class mail or Express Mail through the United States Postal Service (USPS) in October and November of 2001 have had their delivery delayed. See **Mitigation of Delays in Mail Deliveries to the USPTO**, which is posted on the USPTO Internet Web site at:

<http://www.uspto.gov/september11/mitigationofmaildelays.htm>. Some of those papers still have not been received by the USPTO. Although the USPS reports (http://www.usps.com/news/2001/press/pr01_1023fact.htm) that "98% of mail at the Brentwood facility has been sanitized and delivered," the USPS has also informed the USPTO that some of the mail that was in the Brentwood Mail facility on October 21 or 22, 2001 may never be received by the USPTO because of anthrax-related decontamination activities. Some applicants, concerned about papers mailed during this time period that have not been received by the USPTO, have filed duplicate copies of the original correspondence along with a statement that meets the requirement in 37 CFR 1.8(b)(3) prior to any holding of abandonment to permit the Office to more timely act on the correspondence. While Office processing of such duplicates will enable the examination process to move forward, applicants should be aware that the submission of duplicate copies may be unnecessary (and could slow down the processing of the application) and that double charging (collection) of the fees may result from subsequent processing by the Office of the delayed original, which may lead to the submission for, and the processing of, refund requests. The Office will try, however, to avoid double charging (collection) of fees as much as is possible.

I. Timeliness of Replies Whose Delivery to the Office has been Delayed:

In accordance with the Office's usual practice, if a paper was mailed with a certificate of mailing, the Office will determine the **timeliness** (e.g., 35 U.S.C. 133) of the paper based on the certificate of mailing date as set forth in 37 CFR 1.8(a). See **Manual of Patent Examining Procedure (MPEP)**, Eighth Edition, § 512, (August 2001). If a paper was sent by Express Mail, the Office will determine the **timeliness and filing date** of the paper based on the date of deposit with the USPS, which is the "date-in" on the Express Mail mailing label as set forth in 37 CFR 1.10(a). See **MPEP** § 513. Therefore, if the procedures under 37 CFR 1.8 or 1.10 have been followed, any delays in delivery of the paper to the Office will not impact the timeliness of the paper. The Office will process a reply (whose delivery to the Office has been delayed) as timely if the date on the certificate of mailing, or the "date-in" on the Express Mail mailing label, is within the period for reply set forth in the prior Office action or notice.

II. Timeliness of Duplicate Replies Filed when the Original has not been Received by the Office:

A. If the duplicate is, itself, timely filed: If applicant submits a duplicate copy of a paper that has not been received in the Office, the duplicate paper will be processed by the Office as timely if the duplicate is filed within the period for reply to the prior Office action or notice (not considering any extensions of time that may have been available).

B. If a duplicate is filed after the expiration of reply period but with acceptable proof of timely filing: If the original reply was timely mailed within the period from October 13, 2001 to December 1, 2001 using the certificate of mailing procedure under 37 CFR 1.8, and a duplicate

copy is received in the Office after the period for reply has expired, then the Office shall accept the duplicate as the reply, and to have been timely filed, if applicant submits:

- (1) a **copy** of the previously mailed reply and certificate of mailing of the previously mailed reply (the certificate of mailing must be signed and the certificate of mailing must itself indicate the date of mailing); and
- (2) a **statement** that the reply was previously mailed to the USPTO on the date indicated on the certificate of mailing.

It is **not** sufficient to stamp the reply "Duplicate" or "Copy" and to fax the document to the USPTO, a statement is always required. The statement can be part of the fax transmittal cover sheet or the cover letter so long as the fax transmittal sheet is signed as specified below. The statement must be signed by: the person who personally mailed the original reply, a registered patent attorney or agent, the assignee of the entire interest, or the applicant (all of the inventors or the party qualified under 37 CFR 1.42, 1.43 or 1.47). For example, the statement may be: "This is a copy of correspondence that was mailed to the USPTO on _____ date" or "This is a copy of an amendment that was mailed to the USPTO on the date of the certificate of mailing."

If a certificate of mailing as set forth in 37 CFR 1.8 was not used (or if the certificate of mailing was not signed, or if the certificate of mailing did not include a date), and applicant does not have a post card receipt for the correspondence, the Office cannot accord the duplicate correspondence any date other than the date that the duplicate was actually received in the Office. If the duplicate copy was not itself timely filed, applicant should consider filing a petition to revive under 37 CFR 1.137(a) or (b).

To the extent that this treatment of showings as set forth 37 CFR 1.8(b)(3) is less stringent than the requirements set forth in 37 CFR 1.8(b)(3), the provisions of 37 CFR 1.8(b)(3) are hereby sua sponte waived for replies mailed on or after October 13, 2001 and no later than December 1, 2001.

III. Establishing that a Paper other than a Reply was Mailed to the USPTO

A paper that is not a reply to an Office action or is not a correspondence that is required to be filed in the USPTO within a set period of time is NOT entitled to the benefit of a certificate of mailing under 37 CFR 1.8(a). The filing date of such a paper is the actual date of receipt in the USPTO, except as provided by 37 CFR 1.10. For example, a preliminary amendment is not a reply to an Office action and, therefore, would not receive the benefit of a certificate of mailing under 37 CFR 1.8(a). On the other hand, an information disclosure statement (IDS) will be considered to have been filed on the "date that it was received in the Office, or an earlier date of mailing if accompanied by a properly executed certificate of mailing." **See MPEP 609**, page 600-124. An IDS is entitled to the benefit of a certificate of mailing under 37 CFR 1.8(a) since the IDS is a correspondence that is required to be filed in the USPTO within a set period of time. To establish that a paper not entitled to the benefit of a certificate of mailing under 37 CFR 1.8(a) was filed in the USPTO, applicant must have used Express Mail and comply with the provisions of 37 CFR 1.10, or have a post card receipt establishing that the paper was actually received in the USPTO. Other than in these circumstances, the rules do not provide a mechanism for establishing that such a paper was filed in the USPTO.

IV. Office Will Try to Call Before Abandoning Applications Without a Reply:

In most circumstances, before holding an application to be abandoned, staff from the Technology Centers and the Office of Patent Publication will attempt to call applicants to see if a reply has been previously filed. If a reply has been filed, applicant will be requested to fax (or file) a duplicate copy of the prior (original) paper along with a showing as set forth in 37 CFR 1.8(b)(3) in order to avoid the application from being held abandoned.

If applicant files a duplicate with an acceptable showing as set forth in 37 CFR 1.8(b)(3), it will

avoid both the Office holding the application as abandoned, and the processing delays associated with the withdrawal of such abandonment.

V. Duplicate Fee Charges (Collections) are Possible When Duplicates are Filed:

When the Office is processing a duplicate before processing the original, the Office shall charge (collect) all fees that are due for the proper processing of the paper, and will not process any papers that are not accompanied by the appropriate fee. Accordingly, applicants should expect that the same fees may inadvertently be charged (collected) when the Office later processes the original paper. The Office will try to avoid this type of double charging (collecting) by checking to see if the fees required to process a delayed original paper were previously charged (collected) and, if previously charged (collected), the Office will not charge (collect) the fees a second time. The Office, however, cannot guarantee that double charging (collecting) will not occur. If the Office processes fees with both the duplicate and then the original papers, applicant may request a refund under 37 CFR 1.26. If the application has been allowed, the refund request should be filed after the patent has been issued in order to avoid printing delays. When the original paper corresponding to the duplicate is received, the original paper will be attached to the duplicate in the application file wrapper and will not be listed as a separate contents entry for the application in the Office's records. This procedure will be used notwithstanding the procedure set forth in MPEP 719.01(a).

VI. How to File a Duplicate Reply during Examination or after Allowance:

A. If the Application is in a Technology Center: If applicant desires to file a duplicate copy of a reply to an Office action, with an appropriate showing as set forth in 37 CFR 1.8(b)(3), the duplicate should be faxed to the appropriate Technology Center. The reply facsimile numbers for each Technology Center that should be used are posted on the USPTO Internet web site at: <http://www.uspto.gov/september11/faxnotice.htm>.

B. If the Application has been Allowed: If applicant desires to file a duplicate Issue Fee transmittal (e.g., a duplicate PTOL-85B) in order to pay the issue fee and any publication fee, along with a duplicate copy of other post allowance correspondence that was submitted with the issue fee transmittal, accompanied by an appropriate showing as set forth 37 CFR 1.8(b)(3), the duplicate submission(s) and the showing(s) should be faxed to Box Issue Fee: (703) 746-4000. If an amendment under 37 CFR 1.312 was mailed before payment of the issue fee, and the Office has not yet received the amendment, applicant should include a copy of the amendment (and a statement explaining when the amendment was filed) with the issue fee payment so that the amendment under 37 CFR 1.312 is not treated as having been filed after payment of the issue fee, and therefore not entered (because amendments after payment of the issue fee are no longer permitted).

VII. Filing of Duplicate New Applications and Replies to OIPE:

The USPTO appreciates, that, where warranted, applicants should take advantage of 37 CFR 1.8 (b) and 1.10(e), which permits the filing of duplicate copies of prior correspondence in place of lost or missing originals. While applicants should, as a general rule, promptly file a duplicate (of a new application filing or a reply to an OIPE notice) when they become aware that the Office has not received, and may not ever receive, an item of correspondence, the level of urgency usually associated with such action should take into account the fact that the USPTO expects to receive all, or substantially all, of the delayed correspondence. In addition, correspondence will be treated as filed (37 CFR 1.10) or timely (37 CFR 1.8), if applicant originally filed under those provisions regardless of the length of time that the correspondence took to reach the Office. In the event the Office has not received the original by March 1, 2002 applicant then should file a duplicate. The Office will mail a return post card receipt and/or filing receipt or notice, as it usually does, when correspondence is received by the Office so applicant will be informed when delayed correspondence has been received.

When the USPTO receives a duplicate submission, it shall consider a **showing** that a reply was timely mailed as set forth 37 CFR 1.8(b), or a **petition** for a filing date under 37 CFR 1.10(e), to have been timely filed so long as the showing or petition is filed by May of 2002. **To the extent that this standard for timeliness is less stringent than the requirements set forth in 37 CFR 1.8(b)(1), 1.10(e)(1) and 1.181(f), the provisions of 37 CFR 1.8(b)(1), 1.10(e)(1) and 1.181(f) are hereby sua sponte waived for applications and papers mailed on or after October 13, 2001 and no later than December 1, 2001.** Where there is a special need, however, applicants should take advantage of the rules and file duplicates without delay. Special needs could include the following: applications and correspondence mailed on or after October 17, and before October 23, 2001 that have not yet been received by the Office, Patent Cooperation Treaty application filings where priority has been claimed, design applications, replies to a Notice of Incomplete Application (filing date not granted) which was mailed under 37 CFR 1.8, and where certified copies of an application will be needed for priority purposes. In all other situations, before filing a duplicate of a prior mailed correspondence pursuant to 37 CFR 1.8(b) and 1.10(e), applicants might want to wait to see if the original is later received.

If correspondence sent via Express Mail was returned to applicant by the USPS, applicants should not file a duplicate, and should instead mail the original correspondence back to the USPTO as described in the notice "Suspension of the 'Express Mail' Service of United States Postal Service for mail addressed to ZIP Codes 202xx through 205xx" that is posted on the USPTO Internet Web site at: <http://www.uspto.gov/september11/uspmaildisrup.htm>. Applicants who did not file an application using Express Mail may wish to consider filing a duplicate copy of the application via Express Mail, and **not** including the basic filing fee, or an authorization to charge the basic filing fee to a deposit account. When a duplicate application is submitted, applicant should anticipate that the duplicate (copy) application will be processed as a new application, any fees due will be attempted to be collected (as by either charging a deposit account if an authorization is given, or by mailing a Notice to File Missing Parts, requiring the filing fee(s)), and a filing receipt mailed. If the filing date accorded to the duplicate copy is an earlier filing date than that accorded the application that was previously mailed by first class mail, then applicant should respond to the Notice to File Missing Parts and pay the basic filing fee. If the application that was previously mailed by first class mail is given a filing date before that of the duplicate, applicant need not reply to the Notice to File Missing Parts in the duplicate application, and can just prosecute the original application (thereby allowing the later-filed duplicate application to go abandoned).

When applicant mails a reply to a Notice from OIPE using a certificate of mailing, the reply will be considered to be timely so long as the certificate of mailing was dated before the due date set in the Notice, regardless of the length of time that it took to reach the USPTO. If the date of receipt of the correspondence was important, and applicant did not use Express Mail, and the response has not yet been received, applicant may wish to file a duplicate copy of the reply by Express Mail. An example of such a situation would be where a reply to a Notice of Omitted Items included a copy of a missing page of specification and requested a filing date of the date of receipt of the page of specification. The duplicate correspondence mailed to the Office pursuant to the Express Mail provisions of 37 CFR 1.10 will be given a filing date of the "date in" accorded by the USPS. If the duplicate is faxed to OIPE, the correspondence will be given a filing date as of the date of receipt, or if the actual date of receipt is a Saturday, Sunday or Federal Holiday, the next business day (see 37 CFR 1.6(a)(3)).

At the present time applications held in OIPE that are awaiting replies will not be processed as abandoned (if a reply could have been timely made during this period of delayed mail) and, therefore, calls requesting applicants to submit duplicate copies of replies to such notices will not generally be made. Calls to request such papers may be made for design applications.

VIII. Patent Term Adjustment:

Applications filed on or after May 29, 2000 may be eligible for patent term adjustment if issue of the patent has been delayed due to the failure of the Office to meet one of the time periods set forth in 35 U.S.C. 154(b)(1). See 35 U.S.C. 154(b). 37 CFR 1.703(f) provides that the date indicated on any certificate of mailing or transmission under 37 CFR 1.8 is not taken into account

in a patent term adjustment calculation. If a reply to any Office action or notice is filed more than three months after the mailing date of the Office action or notice, the period between the date that is three months after the mailing date of the Office action or notice and the date of receipt (37 CFR 1.6) of the reply is considered a failure to engage in reasonable efforts to conclude prosecution, and any patent term adjustment to which the applicant would otherwise be entitled is required to be reduced by this period. See 35 U.S.C. 154(b)(2)(C)(ii) and 37 CFR 1.704(b). 35 U.S.C. 154(b)(3)(C) and 37 CFR 1.705(c), however, provide that an applicant may request reinstatement of all or part of the period of adjustment reduced pursuant to 35 U.S.C. 154(b)(2)(C) and 37 CFR 1.704(b) for failing to reply to an Office action or notice within three months of the date of mailing of the Office action or notice if the applicant provides a showing that, in spite of all due care, the applicant was unable to reply to the Office action or notice within three months of the date of mailing of the Office action or notice, but 35 U.S.C. 154(b)(3)(C) does not permit the Office to grant any request for reinstatement for more than three additional months for each reply beyond three months from the date of mailing of the Office action or notice.

If a reply to an Office action or notice was mailed on or after October 13, 2001 and no later than December 1, 2001 (as shown on a certificate of mailing under 37 CFR 1.8), and the applicant is otherwise entitled to patent term adjustment (or additional patent term adjustment) but for the fact that there was a reduction of such patent term adjustment under 35 U.S.C. 154(b)(2)(C)(ii) and 37 CFR 1.704(b) due to the receipt of such reply by the Office more than three business days after the date indicated on the certificate of mailing, the Office will consider the USPS mail situation discussed in this notice to constitute a sufficient showing that, in spite of all due care, the applicant was unable to reply to the Office action or notice within three months of the date of mailing of the Office action or notice. In this situation, the Office will, subject to the conditions set forth below, reinstate a period equal to the period beginning on the date that is four business days after the date indicated on the certificate of mailing on the reply and the date of receipt (37 CFR 1.6) of the reply in the Office up to a maximum of three months.

If an applicant's request for reinstatement of patent term adjustment for the reason set forth above is the sole basis for requesting a change to the patent term adjustment indicated on the notice of allowance, the Office will waive the requirements of 37 CFR 1.705 (including fees) if the applicant submits a request for reinstatement of patent term meeting the following conditions:

(1) The request is submitted no later than the payment of the issue fee but no earlier than the date of mailing of the notice of allowance (unless the paper that was delayed in the mail was the issue fee payment or other paper submitted with or after payment of the issue fee, in which case the request must be submitted as soon as possible but no later than the day before the date of issue of the patent).

(2) The request is transmitted by facsimile to the Office of Petitions at (703)308-6916.

(3) The request includes:

- (a) a copy of the part of page with the certificate of mailing under 37 CFR 1.8 and a description of the paper (e.g., amendment, issue fee transmittal, notice of appeal);
- (b) the date of receipt in the Office of the paper; and
- (c) the number of days requested to be reinstated as a result of the USPS mail situation discussed in this notice.

In addition, if applicant has access to the Patent Application Information Retrieval (PAIR) system, a copy of the PAIR contents records with the entry highlighted should also be included.

Applicants are again reminded that to maximize patent term adjustment they may wish to consider filing replies to Office actions: (1) under the "Express Mail" provisions of 37 CFR 1.10; (2) by facsimile; or (3) by hand-delivery. See **Changes to Implement Patent Term Adjustment Under**

Twenty-Year Patent Term, 65 **Fed. Reg.** 56366, 56376 (Sept. 18, 2000), 1239 **Off. Gaz. Pat. Office** 14, 22-23 (Oct. 3, 2000) (final rule) (response to comment 10).

IX. Contact Information:

If you have a question relating to the status of a reply for an application in a Technology Center, please contact the Customer Service Representative of that Technology Center. If you have a question relating to the receipt of a new application or a reply for an application in OIPE, please contact the Customer Service Center in OIPE at (703) 308-1202. If you have a question relating to the receipt of post allowance correspondence, including issue and publication fee payments, please contact the Customer Service Center of the Office of Publications at (703) 305-8283.

Questions concerning this notice should be directed to Darnell Jayne, Legal Advisor, Office of Patent Legal Administration at (703) 308-6906.

Date: 12/20/2001

Signed: /s/ Robert Spar for
Stephen G. Kunin
Deputy Commissioner
for Patent Examination Policy

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